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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,659	10/06/2003	Jai Rawat	AOL0040C	5799

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,659

Applicant(s)

RAWAT ET AL.

Examiner

Nabil M. El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

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1. Claims 1-64 are pending in this application.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 6,662,340, hereinafter "340". Although the conflicting claims are not identical, they are not patentably distinct from each other because both "340" and the instant application disclose a client based method, system, and computer program product for filling out an electronic form automatically without previous form examination or storing of mapping information about the form by identifying form fields based on analysis of visible field labels. Independent claims 1, 22, and 43 in "340" disclose the same limitations as claims 1 and 2, 22 and 23, and 43 and 44 in the instant application, while dependent claims in both "340" and the instant application are similar.

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4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows: the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No.09/561,449, filed on April 28, 2000, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims, which are fully supported under 35 U.S.C. 112 by the earlier parent application, have the effective filing date of that earlier parent application.

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (e.g. page 3, line 34). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following phrases are not clearly understood and making the claims vague or indefinite:

a) "without previously mapping ... said form.... mapping said form", in claim 1, lines 2-3, claim 22, lines 2-6, and claim 43, lines 2-8, first, it is unclear if the first use of the word "mapping" is any different from the second use of the word "mapping". The use of "without mapping" and then the use of "mapping" is contradictory, resulting in confusion, second, it is unclear what "previously" here means, previous of what, or when exactly in the process of form filling.

b) "visible form elements" and "form fields", claim 1, lines 3 and 4, claim 22, lines 5 and 6; and claim 43, lines 7 and 8; first, it is not clear what is the relation between "form elements" and "form fields", or what is the difference between them; second, "form elements" and "form fields" may be a name for the same thing, specially when both are

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visible in the form, third, it is not clear if “visible for elements” here indicated that there are other form elements that are not visible in the form.

c) “populating form fields” .. correct data .. correct format”, in claim 1, lines 2-3, claim 22, lines 2-6, and claim 43, lines 2-8, it is unclear how the form fields are populated, from where the “correct data” is retrieved, why the data is labeled “correct”, how the “correct format” is known. If the data is stored somewhere, then whatever data is stored and with whatever format it is stored with, the data will be retrieved, so labeling the data or the format as “correct” may unnecessarily give the indication that other data or format is incorrect, which is meaningless for automatic filling.

d) “said step of step” in claim 14, line 1; is not clearly understood;

e) “traversing form elements in a second sequence ...a reverse of a first sequence” in claim 16, lines 2-3, claim 37, lines 3-4, and claim 58, lines 2-3, are form elements meant to be the same as page elements in “traversing page elements in a first sequence” in claim 3, line 3, claim 24, line 4, and claim 45, line 3, respectively, and if the first sequence referred to in claims 16, 37, and 58 is the same first sequence in claims 3, 24, and 45, respectively, then the phrase should read “traversing form elements in a second sequence ...a reverse of the first sequence”.

f) “re-formatting and said correct data” in claim 18, line 2, claim 39, line 2, and claim 60, line 2, is not clearly understood.

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g) “examining general vicinity of said page in all directions from the field”, claim 4, 25, and 46, lines 6-7, it is unclear what vicinity is being examined, if the “field” is the center, then what is being examined is the general vicinity of the “field” in all directions not the “page”.

B. The following has no antecedent basis:

a) “page elements”, claim 3, line 2.

b) “page coordinated”, claim 4, line 6.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 21, 22, 42, 43, and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Light et al. (US 6,192,380), hereinafter “Light”.

11. As to claim 1, Light discloses a client-based method for filling out an electronic form automatically without previously mapping or examining said form, comprising mapping the form based on analysis of visible form elements, and populating form fields with correct data in correct format without user intervention, according to said mapping (abstract; col. 3, lines 48-62).

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12. As to claim 22, the claim is rejected for the same reasons as claim 1 above. In addition, the claim is rejected for the same reasons as claim 1 above. In addition, a computer program product for filling out an electronic form automatically without previously mapping or examining said form, said computer program product comprising a tangible medium having computer readable code embodied thereon, the computer code including program code means for mapping said form based on analysis of visible form elements; and populating form fields with correct data in correct format without user intervention, according to said mapping, is inherent in Light's disclosure.

13. As to claim 43, the claim is rejected for the same reasons as claims 1, and 22 above. In addition, Light discloses a client-based system for filling out an electronic form automatically without previously mapping or examining said form, comprising a client; at least one data file; rules for mapping visible form elements to correct data from said file; and computer-readable code means for mapping said form based on analysis of visible form elements; and populating form fields with correct data in correct format without user intervention, according to said mapping; wherein said code is executable on said client, and wherein, said analogs, said rules, and said code are stored on said client (abstract; col. 3, lines 48-62).

14. As to claims 21, 42, and 63 the claims are rejected for the same reasons as claims 1, 22, and 43 above. In addition, it is inherent property to fields in a form to have the ability to be hidden when they are treated as objects.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2-20, 23-41, 44-62, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Light in view of Quass et al. (US 2002/0083068), hereinafter "Quass".

17. As to claims 2, 23, and 44, the claims are rejected for the same reasons as claims 1, 22, and 43 above. In addition, Light discloses identifying fields based on analysis of visible field labels proximate said fields, when said labels are present (col. 3, lines 48-62; and col. 5, lines 55-60). Light does not disclose evaluating user visible display format hints proximate said fields to determine required display format. Quass, on the other hand, discloses evaluating user visible display format hints proximate said fields to determine required display format ([0052]). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Light and Quass in order to enhance Light's automatic form fill-in method by preserving the format information required for display.

18. As to claims 3, 24, and 45, the claims are rejected for the same reasons as claims 1, 2, 22, 23, 43 and 45 above. In addition, Light discloses traversing page elements in a first sequence (inherent in col. 3, line 48).

19. As to claims 4, 25, and 46, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Quass discloses analyzing text expressions in adjacent cells, if a field is positioned in a table cell, analyzing a text expression within a predetermined number of words and in at least one predetermined direction from said fields, examining general

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vicinity of said page, based on page coordinates, in all directions from the field and analyzing text expression closest to said field, and disregarding text expressions embedded within parentheses or quotation marks ([0054]).

20. As to claims 5, 26, and 47, the claims are rejected for the same reasons as claims 1-4, 22-25, and 43-46 above. In addition, Light and Quass discloses comparing the analyzed text expressions with entries in a field label dictionary to find closest match with a metadata expression, wherein said field is mapped to correct metadata (Light, col. 3, lines 60-62, col. 5, lines 61-65; Quass, [0014]).

21. As to claim 6, 7, 27, 28, 48, and 49, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Quass discloses mapping the field according to context when the field lacks a visible field label by identifying mapping of at least one field preceding a current field in said first sequence, and mapping said current field based on said mapping of said preceding field ([0052] and [0054]).

22. As to claims 8, 29, and 50, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Light discloses mapping the field based on analysis of a programmatic field name when a field lacks a visible field label (col. 3, lines 3-5, 48-65).

23. As to claims 9, 30, and 51, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Light discloses when a field lacks a visible field label, comparing the field's default value with entries in a field label dictionary to find closest match

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with a metadata expression, wherein said field is mapped to correct metadata (col. 3, lines 60-62; and col. 5, lines 61-65).

24. As to claim 10, 31, and 52, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Quass discloses if a field is a select field, comparing selection options with entries in a field label dictionary to find closest match with a metadata expression, wherein said field is mapped to correct metadata ([0037], and Fig. 3).

25. As to claims 11, 32, and 53, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Quass discloses for sets of radio buttons, creating a new object for each set ([0042], [0044], and [0056]).

26. As to claims 12, 15, 33, 36, 54, and 57, the claims are rejected for the same reasons as claims 1-3, 22-24, and 43-45 above. In addition, Quass discloses identifying block type, wherein a block comprises a plurality of related fields ([0014]). Moreover, it would have been obvious to one skilled in the art at the time of the invention that a set of form fields as classified by Quass would constitute related field such as billing address; shipping address; credit card information; and email address.

27. As to claims 13, 34, and 55, the claims are rejected for the same reasons as claims 1-3, 12, 22-24, 33, 34-45, and 54 above. In addition, Quass, discloses comparing programmatic field name of at least a current field with arrays of metadata expressions for each block type; comparing visible form elements for at least said current field with arrays of metadata expressions for each block type; and where said current field occupies a table cell, analyzing

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text expressions at least from first cell of said table to cell occupied by said current field ([0010], [0014], [0016], and [0054]).

28. As to claims 14, 35, and 56, the claims are rejected for the same reasons as claims 1-3, 12, 13, 22-24, 33, 34, 43-45, 54, and 55 above. In addition, Quass discloses when a close match is found, mapping said field to said block type ([0037], and Fig. 3).

29. As to claims 16, 37, and 58, the claims are rejected for the same reasons as claims 1-2, 22-23, and 43-44 above. In addition, Quass discloses traversing form elements in a second sequence, said second sequence a reverse of a first sequence, identifying mapping of at least a field following a current field in said second sequence; and mapping said current field based on said mapping of said following field ([0054]).

30. As to claims 17, 38, and 59, the claims are rejected for the same reasons as claims 1-2, 22-23, and 43-44 above. In addition, Quass discloses traversing form elements in a first sequence; analyzing a visible display format hint proximate a field; comparing said analyzed display format hint with a dictionary of data entry prompts; mapping said field to a display format based on said comparison ([0052] and [0054]).

31. As to claims 18, 39, and 60, the claims are rejected for the same reasons as claims 1-2, 17, 22-23, 38, 43-44, and 59 above. In addition, Quass discloses any of concatenating, truncating and re-formatting of said correct data according to said display format ([0052]).

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32. As to claims 19, 40, and 61, the claims are rejected for the same reasons as claims 1-2, 17, 22-23, 38, 43-44, and 59 above. In addition, Quass discloses for a field lacking a proximate visible display format hint, mapping current field to same display format of a preceding field if both fields are the same field type ([0052] and [0054]).

33. As to claims 20, 41, and 62, the claims are rejected for the same reasons as claims 1, 22, and 43 above. In addition, Quass discloses identifying a form as a checkout form ([0012]).

34. As to claim 64, both Light and Quass disclose a data file in a database used to map the form element. However, it would have been obvious to one skilled in the art at the time of the invention that such a database may reside on either the client or on the server without affecting the functionality of the automatic form fill-in system.

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yankovich et al. (US 2003/0110443) ; Malcolm (US 2002/0087479); Gupta et al. (US 6,199,079); Kolling et al. (US 6,385,595); Wu et al. (US 2002/0083095); Farahmand et al. (US 2002/0116387); and Hunt et al. (US 6,496,855).

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M. El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 24, 2005

A handwritten signature in black ink, appearing to read 'N. El-Hady', with a long, sweeping horizontal stroke extending to the right.

Nabil El-Hady, Ph.D., M.B.A.
Primary Patent Examiner
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